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| 09/669,805 | 09/26/2000 | Scott C. Harris | RTA/SCH | 3717 |

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| | | |
|--------------------------------------|---|-----------------------|
| In re Application of | : | |
| Scott C. Harris | : | DECISION ON PETITION |
| Application No. 09/669,805 | : | TO INVOKE SUPERVISORY |
| Filed: September 26, 2000 | : | AUTHORITY |
| Attorney Docket No.: RTA/SCH | : | UNDER 37 CFR 1.181 |
| For: REAL TIME AUCTION WITH END GAME | : | |

This is in response to applicant's petition to invoke supervisory authority under 37 CFR 1.181 filed July 3, 2008 requesting review of the "pattern of conduct" pertaining to the generation of nine "notices of nonresponsiveness" since May 19, 2005. The delay in answering this petition is regretted.

The petition is **DENIED**.

Applicant alleges that over the course of prosecution of this application the examiner has abused the procedure of non-responsiveness by holding various responses to be non-responsive so as to evade examination on the merits as evidenced by the issuance of nine such notices since May 19, 2005. It is further alleged that "(w)hile some of the issues raised by the non-responsiveness notices have some colorable basis in fact, others have no basis in fact whatsoever."

A review of the file record reveals the following:

1. A non-final Office action was mailed May 19, 2005 that included a restriction requirement and telephonic election by applicant.
2. Applicant's reply was filed on October 19, 2005.
3. A Notice of Non-Compliant Amendment from the examiner was mailed January 17, 2006 due to applicant's failure to include appropriate markings for changes made to the specification and failure to use proper status identifiers for the non-elected claims that were withdrawn from further consideration.
4. A reply from applicant was filed February 17, 2006 correcting the above noted deficiencies.
5. A Notice of Non-Responsive Amendment was mailed April 19, 2006 due to applicant's failure to submit replacement drawings correcting the drawing deficiencies noted in the Office action of May 19, 2005.
6. A reply was filed May 16, 2006 that included drawing sheets labeled as "replacement" sheets.

7. A Notice of Non-Compliant Amendment was mailed July 27, 2006 due to applicant's failure to identify and explain the changes made to the drawings and because the reply was initialed, not signed.
8. A reply was filed August 9, 2006.
9. A Notice of Non-Responsive Amendment was mailed October 20, 2006 due to applicant's failure to properly address the drawing issue.
10. A reply was filed November 20, 2006.
11. A Notice of Non-Compliant Amendment (from the Legal Instruments Examiner) was mailed February 8, 2007 due to applicant's failure to properly present changes to the specification.
12. A reply was filed March 4, 2007.
13. A Final Office action was mailed May 15, 2007.
14. A proposed amendment after final was filed August 28, 2007.
15. An Advisory action/Notice of Non-Compliant Amendment was mailed September 12, 2007 due to applicant's failure to include replacement drawing sheets.
16. A reply was filed September 17, 2007 wherein the previously submitted annotated drawing sheets were resubmitted with the word "annotated" scribbled out and the word "replacement" hand written thereover.
17. An Advisory action/Notice of Non-Compliant Amendment was mailed September 28, 2007 due to applicant's failure to present proper replacement drawing sheets.
18. A Notice of Appeal was filed October 15, 2007.
19. A first Appeal Brief was filed December 16, 2007.
20. A Notification of Non-Compliant Appeal Brief was mailed March 13, 2008.
21. A second Appeal Brief was filed April 11, 2008.
22. A Notification of Non-Compliant Appeal Brief was mailed June 18, 2008.
23. A third Appeal Brief was filed July 3, 2008.

From the above outlined file record, it should be noted that there were not nine "notices of nonresponsiveness" as applicant alleges. Rather the record reveals that there were five Notices of Non-Compliant Amendment (four from the examiner and one from the Legal Instruments Examiner), two Notices of Non-Responsive Amendment and two Notices of Defective Appeal Brief.

With respect to the Notices of Non-Compliant Amendment, 37 CFR 1.121 is quite clear with regard to the manner for filing an amendment. This revised amendment practice has been in effect since July 30, 2003 and, as such, it is not unreasonable to expect applicant to have been fully aware of this practice and to follow the requirements of this practice. See *Changes to Implement Electronic Maintenance of Official Patent Application Records*, 68 Fed. Reg. 38611, 38615 (June 30, 2003), 1272 Off. Gaz. Pat. Office 197 (July 29, 2003)(final rule) and MPEP 714.

In the paragraph bridging pages 2-3 of the petition, Applicant seeks to explain that his reply of October 19, 2005 did not indicate claims as "withdrawn" because the restriction had not yet been made final. Be that as it may, 37 CFR 1.121(c) is clear that the claim listing is to include the status of every claim. The Office action mailed May 19, 2005 clearly stated that non-elected claims were withdrawn. See page 3, lines 7-9, of the Office action. Thus, these claims should

have been properly identified with the status identifier "withdrawn" irrespective of whether or not the restriction requirement was final. Accordingly, the examiner's non-compliant notice was clearly appropriate for this reason.

Moreover, it is further noted that this first non-compliant notice also pointed out applicant's failure to identify the changes being made to the specification. Thus, the non-compliant notice addressed more than just applicant's failure to utilize proper status identifiers. Applicant's remarks in the petition do not note this fact.

Accordingly, the Notice of Non-Compliant Amendment mailed January 17, 2006 was clearly appropriate and made necessary by the deficiencies of applicant's reply and was neither arbitrary, capricious nor an abuse of procedure.

With respect to the Notice of Non-Responsive Amendment mailed April 19, 2006, applicant is correct that the deficiency noted therein should have been included in the first non-compliant notice. Unfortunately, it was not. Nevertheless, the examiner's initial failure to note the deficiency does not excuse applicant from having to include an appropriate response in regard to this issue. In particular, 37 CFR 1.111(b) clearly states that applicant is to respond to every ground of objection and rejection and 37 CFR 1.121(d) clearly states the procedure for amending drawings. It is further noted that applicant received a new one month time period to make the necessary corrections.

Notwithstanding applicant's remarks with respect to the Notice of Non-Compliant Amendment mailed July 27, 2006, 37 CFR 1.121(d) is explicit "(a)ll changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper". Applicant failed to include any identification whatsoever of what changes were made, let alone provide a detailed explanation of the changes made. Further, given that applicant's reply of May 16, 2006 was the reply that first created the problem to which this Notice was directed, it is unclear how it could have been expected that the examiner could have raised it sooner or should have known that applicant would not provide a detailed explanation of the changes made as 37 CFR 1.121(d) clearly requires.

With respect to the remarks regarding applicant's use of initials for the electronic signature, it is noted that at no time before the instant petition did applicant indicate to the examiner that he had chosen initials to constitute his adopted e-signature, including the reply directly responding to the Notice of July 27, 2006. Further, it is noted that all previous replies from applicant were signed with the name "Scott Harris". 37 CFR 1.181 states, in pertinent part:

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

There is no explanation from applicant as to why this issue was not earlier raised within the two-month period from the mailing date of the action now being complained about. In view of the

fact that Applicant failed to raise this as an issue previously, it is untimely to do so now in the instant petition filed two years after the fact. Moreover, all correspondence from applicant since this time has included a proper signature.

The Notice of Non-Responsive Amendment mailed October 20, 2006 was necessitated in large part because applicant's reply of August 9, 2006 incorrectly stated that no changes were made to the drawings when, in fact, at least "replacement" Fig. 5 showed some kind of hand-written and unidentifiable addition to the box labeled "my agent". Applicant finally properly corrected this deficiency in a reply filed November 20, 2006.

Applicant next complains about the generation of yet another Notice of Non-Compliant Amendment on February 8, 2007. However, this Notice came from the Legal Instruments Examiner (LIE), not the patent examiner assigned to examine the application. Nevertheless, the issue raised by the LIE pertained to applicant's failure to comply with the requirements for properly presenting amendments to the specification. There is no discussion from applicant that this Notice was incorrect.

With respect to the Notice of Non-Compliant Amendment accompanying the Advisory action mailed September 12, 2007, applicant states that replacement drawings were provided. This is incorrect. The reply of August 28, 2007 included only one set of drawings and this set was clearly labeled to be "annotated" drawings. "Annotated" drawings are not "replacement" drawings and the inclusion of annotated drawings does not obviate the requirement for "replacement" or "new" drawings. Moreover, it is noted that the examiner specifically included information on how to effect drawing changes (page 4) in the final rejection to ensure that applicant was fully aware of the proper procedure to correct drawings and yet properly corrected drawings were not filed.

In response to the above non-compliant notice, applicant merely scribbled out the word "annotated" and hand-wrote "replacement" instead. Thus, in response to the non-compliant notice, applicant merely resubmitted the annotated sheets under the guise of being replacement sheets. The resulting "replacement" sheets then improperly possessed marked up changes and clearly did not comply with 37 CFR 1.121(d) and 37 CFR 1.84. The action taken by applicant in this regard directly led to the next Notice of Non-Compliant Amendment mailed September 28, 2007.

None of the above notices evidence an abuse of procedure by the examiner nor is there any indication that they were the result of arbitrary and capricious action on the part of the examiner. Rather, it would appear that such notices were the result of omissions by the applicant and an inability to comply with the manner for making amendments clearly set forth by 37 CFR 1.121.

With respect to applicant's remarks concerning the first Notice of Defective Appeal Brief mailed March 13, 2008, applicant states that the status of the canceled claims was indicated as canceled. Review of the Status of Claims section of the brief filed December 16, 2007 (see page 4) fails to evidence any discussion of any claims as having been canceled. See 37 CFR 41.37(c)(iii). In fact, this section only mentions claims 2, 5, 7, and 13-29. Furthermore, perusal of this appeal brief fails to find any mention of canceled claims anywhere therein.

Further with respect to applicant's remarks regarding the defective appeal brief notice, 37 CFR 41.37(c) sets forth what sections are required in an appeal brief and what is to be included in each section. This also applies in regard to the second defective appeal brief notice mailed June 18, 2008.

The two appeal briefs filed December 16, 2007 and April 11, 2008 were properly held to be defective for reasons advanced by the examiner and there is no evidence to indicate that the examiner acted arbitrarily or capriciously or otherwise abused the procedure.

In summary, the instant petition is **DENIED**.

The application is being returned to the examining art unit for consideration of the most recently filed appeal brief and the preparation of an Examiner's Answer.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Daniel P. Stodola at (571) 272-7087.



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TL/DS: 4/14/11

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